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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/808,553

03/25/2004

Vincent Bryan

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05/10/2007

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EXAMINER

CUMBERLEDGE, JERRY L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

05/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,553

Applicant(s)

BRYAN ET AL.

Examiner

Jerry Cumberledge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/27/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to because the drawings are blurry and illegible. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 49-67 are rejected under 35 U.S.C. 102(e) as being anticipated by
Michelson (US Pat. 6,440,139).

Michelson discloses an apparatus for preparing a space in the human spine to receive an insert between adjacent vertebral bodies, comprising: a handle (Fig. 18A, ref. 214); a shaft (Fig. 18A, elongated portion near ref. numeral 208) operably connected to said handle; a mounting member (column 15, lines 13-17) disposed at a distal end of said shaft; a drive mechanism (column 15, lines 13-17); a power source operably connected to said drive mechanism (column 15, lines 13-17); and an abrading element (Fig. 18A, ref. 202) mounted on said mounting member for movement by said drive mechanism, said abrading element having at least one abrading surface selected to create a predetermined surface contour in one of the adjacent vertebral bodies as said abrading element is moved by said drive mechanism (Fig. 18A, ref. 206). The abrading element includes outwardly facing first and second abrading surfaces (Fig. 18A, flat outer surfaces of ref. 206), and said first and second abrading surfaces are inclined related to one another, since they are at angles relative to each other around the outer periphery of the abrading element. The abrading element is detachable from said mounting element (Fig. 18A). The drive mechanism is adapted to produce one of an oscillating rotation and a vibratory motion of the abrading element (column 16, lines 12-16, e.g. oscillating and vibrating cutters). The drive mechanism is operable to move said abrading element in at least two degrees of freedom. The apparatus further

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comprises a suction mechanism for removing bits of debris created by said abrading surface of said abrading element (column 16, lines 25-31). The apparatus includes an irrigation channel configured through said shaft for delivering irrigation fluid to the surgical site (column 16, lines 25-31). The apparatus includes at least one stop member (Fig. 16, ref. 180) to limit the depth of travel of said abrading element into the spine. The apparatus further comprises a guide (Fig. 46, ref. 500) having an opening (Fig. 46, ref. 516) for providing protected access to the disc space and the adjacent vertebral bodies, said opening being configured for passage of said abrading element through said guide; and first and second disc penetrating extensions (Fig. 46, ref. 551a, 551b) extending from said guide for insertion into the disc space between the adjacent vertebral bodies, each of said disc penetrating extensions having a portion for bearing against each of the adjacent endplates of the adjacent vertebral bodies, each of said portions of said disc penetrating extensions having an upper surface adapted to contact one of the adjacent endplates of the adjacent vertebral bodies and a lower surface adapted to contact the other of the adjacent endplates of the adjacent vertebral bodies (Fig. 46, upper and lower surfaces of refs. 551a and 551b), said portions of said disc penetrating extensions having a height between said upper and lower surfaces and a length sufficient to properly align and distance apart the adjacent vertebral bodies. The upper and lower surfaces are parallel to each other along a substantial portion of the length thereof (Fig. 46). The guide has an external surface (Fig. 46, outer surface of guide) at its distal end and said disc penetrating extensions are at least in part coextensive with said external surface (Fig. 46, where the extensions attach to the

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guide). The disc penetrating extensions are diametrically opposed to each other and spaced apart from one another to provide access to the adjacent vertebral bodies from within the disc space (Fig. 46). The height of said disc penetrating extensions have at least a portion that approximates the height of a normal disc space between the adjacent vertebral bodies (Fig. 46). The disc penetrating extensions have a tapered leading end (Fig. 46, curved tips of guide) to facilitate placement of said disc penetrating extensions into the disc space, said portion of said disc penetrating extensions having opposite surfaces for bearing against the endplates of the adjacent vertebral bodies, said opposite surfaces diverging away from said guide along at least a portion of their length. The upper and lower surfaces converge away from said guide along at least a portion of their length (Fig. 46). The guide conforms at least in part to the exterior surface of the adjacent vertebral bodies (Fig. 46). The apparatus further comprises means for penetrating the two adjacent vertebral bodies (Fig. 68, ref. 1228a and 1228b). The disc penetrating extension has a length greater than one-half the depth of the disc space measured from the anterior aspect to the posterior aspect of the disc space (Fig. 46). The guide has an interior (Fig. 46, inside portion of ref. 46) having a cooperating surface for guiding a corresponding cooperating surface on said mounting member (Fig. 46, ref. 514) (column 18, lines 45-56). The apparatus further comprises an insert (column 21, lines 51-55) sized and shaped to match the space formed in the spine by said abrading element.

With regard to statements of intended use and other functional statements (e.g. ...operable to move said abrading element in at least two degrees of freedom....,

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...adapted to contact one of the adjacent endplates of the adjacent vertebral bodies...), they do not impose any structural limitations on the claims distinguishable over the device of Michelson, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

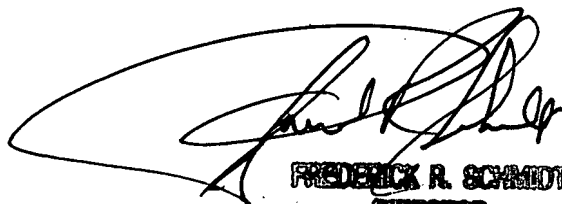
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571) 272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC



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